

Handwritten initials: AS



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------------|------------------|
| 10/055,367 | 01/25/2002 | Anthony E.G. Cass | 620-183 | 7631 |
| 23117 | 7590 | 09/27/2004 | | |
| NIXON & VANDERHYE, PC 1100 N GLEBE ROAD 8TH FLOOR ARLINGTON, VA 22201-4714 | | | EXAMINER FORMAN, BETTY J | |
| | | | ART UNIT 1634 | PAPER NUMBER |

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------|-------------------------------|------------------------------------|--|
| Advisory Action | Application No. 10/055,367 | Applicant(s) CASS, ANTHONY E.G. | |
| | Examiner BJ Forman | Art Unit 1634 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-8,10-13,15-20 and 22-31.

Claim(s) withdrawn from consideration: 32-50.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


 BJ Forman
 Primary Examiner
 Art Unit: 1634

Art Unit: 1634

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's arguments are not commensurate in scope with the claims. Applicant argues that the Reed does not teach the claimed immobilized sensing elements (i.e. polypeptide or fragment, truncation, domain or concatenation thereof) and does not teach labels that undergo a change on ligand binding but instead teaches cell sensing elements. The arguments have been considered but are not found persuasive because, as Applicant acknowledges and as cited in the Office Action, Reed teaches immobilized cells and the immobilized cells comprise a biological sensing element. Because the cells comprising the sensing element are immobilized, the sensing element is also immobilized. Applicant appears to be asserting that the claims require the sensing element be immobilized via direct contact with the surface of the solid support (e.g. covalent attachment between a polypeptide and functional group on the solid support). However, the claims are not so limited. The claims merely require immobilization of the sensing element and as cited in the office action, Reed teaches this element of the invention. Applicant further argues that the label of Reed is used for immunocyto-chemical localization as opposed to detection. The argument has been considered but is not found persuasive because, as Applicant acknowledges, the sensing element of Reed is labeled. The courts have stated that the intended use and/or function of a product does not define the product over the prior art (Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)). Hence, the functionality of the label recited in the claims does not define the label over that of Reed.


BJ FORMAN, PH.D.
PRIMARY EXAMINER